

ESTTA Tracking number: **ESTTA447289**

Filing date: **12/20/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	BC International Cosmetic & Image Services, Inc.
Granted to Date of previous extension	12/25/2011
Address	14901 S. Orange Blossom Trail Orlando, FL 32837 UNITED STATES
Attorney information	Susan Upton Douglass, Esq. Fross Zelnick Lehrman & Zissu, P.C. 866 United Nations Plaza New York, NY 10017 UNITED STATES sdouglass@frosszelnick.com

Applicant Information

Application No	85179358	Publication date	06/28/2011
Opposition Filing Date	12/20/2011	Opposition Period Ends	12/25/2011
Applicant	Guardian Gold Alliance, LLC 100 N. Guadalupe St, Suite 202 Santa Fe, NM 87501 UNITED STATES		

Goods/Services Affected by Opposition

Class 036. All goods and services in the class are opposed, namely: Providing monetary exchange services, namely, exchanging gold of others for cash

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	1990321	Application Date	06/17/1994
Registration Date	07/30/1996	Foreign Priority Date	NONE
Word Mark	HEARTS OF GOLD		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 036. First use: First Use: 1994/07/00 First Use In Commerce: 1994/07/00 charitable fundraising services

Attachments	HEART OF GOLD PROGRAM - Notice of Opposition (F0930501).PDF (6 pages)(261099 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/sud/
Name	Susan Upton Douglass, Esq.
Date	12/20/2011

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 85/179,358
Trademark: HEART OF GOLD PROGRAM
Opposer's Ref: BCI USA TC-11/06631

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BC INTERNATIONAL COSMETIC & IMAGE
SERVICES, INC.,

Opposer,

v.

GUARDIAN GOLD ALLIANCE, LLC,

Applicant.
-----X

Opposition No.

NOTICE OF OPPOSITION

Opposer, BC International Cosmetic & Image Services, Inc., a corporation organized and existing under the laws of Delaware, located and doing business at 14901 South Orange Blossom Trail, Orlando, FL 32837, believes that it will be damaged by registration of the mark HEART OF GOLD PROGRAM, which is the subject of Application Serial No. 85/179,358, published in the Official Gazette on June 28, 2011, and hereby opposes same.

As grounds for the opposition, Opposer alleges as follows:

1. Since at least as early as July 1994, and prior to any date upon which Applicant can rely, Opposer has used in commerce the mark HEARTS OF GOLD for charitable fundraising services, and is continuing to do so. Opposer has invested a substantial amount of time, effort and money in promoting the HEARTS OF GOLD and mark. As a result, the mark has become distinctive of Opposer's services and has come to represent enormous goodwill for Opposer.

2. Opposer is the owner of U.S. Registration No. 1990321, filed on June 17, 1994 and issued on July 30, 1996, for the mark HEARTS OF GOLD for charitable fundraising services. A TARR printout of this registration is made of record. This registration is valid and subsisting, and has become incontestable under Section 15 of the Trademark Act.

3. On November 17, 2010, Applicant filed Application Ser. No. 85/179,358 to register the mark HEART OF GOLD PROGRAM for “providing monetary exchange services, namely, exchanging gold of others for cash” in Class 36, on the basis of intent to use. Upon information and belief, no use of the mark HEART OF GOLD PROGRAM was made by Applicant prior to Applicant’s filing date of November 17, 2010. Therefore, Opposer has priority.

4. The mark that Applicant seeks to register, HEART OF GOLD PROGRAM, is highly similar in sound, meaning and commercial impression to Opposer's HEARTS OF GOLD mark.

5. The mark HEART OF GOLD PROGRAM will be used for a similar category of services for which Opposer has long used its registered mark. Many companies exchange gold for cash as a way to raise money for charities, and thus consumers familiar with Opposer’s HEARTS OF GOLD charitable fundraising will likely believe, based on the similarities of the marks and services, that the services intended to be offered by Applicant under the mark HEART OF GOLD PROGRAM are associated with Opposer or with Opposer's HEARTS OF GOLD services, or to believe that Applicant's services are sponsored, endorsed or licensed by Opposer, or that there is some relationship between Applicant and Opposer.

6. For the above reasons, any use of the mark HEART OF GOLD PROGRAM by Applicant is likely to cause confusion, cause mistake or deceive the public, and cause the public to believe that the services offered under the HEART OF GOLD PROGRAM mark emanate from or are

otherwise sponsored by or endorsed by Opposer, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).


By reason of the foregoing, Opposer will be damaged by the registration of the mark HEART OF GOLD PROGRAM to Applicant.

WHEREFORE, it is respectfully requested that this opposition be sustained and that the registration sought by Application Serial No. 85/179,358 be denied.

Dated: New York, New York
December 20, 2011


Respectfully submitted,

FROSS ZELNICK LEHRMAN
& ZISSU, P.C.

By: 
Susan Upton Douglass
Attorneys for Opposer
866 United Nations Plaza
New York, New York 10017
(212) 813-5900

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing was served by prepaid, first-class mail upon Applicant's attorney, Heinz Grether, Heinz Grether PC, P.O. Box 202858, Austin, Texas 78720, this 20th day of December, 2011.


Susan Upton Douglass

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2011-12-20 12:14:04 ET

Serial Number: 74538698 Assignment Information Trademark Document Retrieval

Registration Number: 1990321

Mark (words only): HEARTS OF GOLD

Standard Character claim: No

Current Status: The registration has been renewed.

Date of Status: 2006-08-31

Filing Date: 1994-06-17

Transformed into a National Application: No

Registration Date: 1996-07-30

Register: Principal

Law Office Assigned: LAW OFFICE 106

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 830 -Post Registration

Date In Location: 2006-08-31

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. BC International Cosmetic & Image Services, Inc.

Address:

BC International Cosmetic & Image Services, Inc.
14901 S. Orange Blossom Trail
Orlando, FL 32837
United States

Legal Entity Type: Corporation

State or Country of Incorporation: Delaware

GOODS AND/OR SERVICES

International Class: 036

Class Status: Active

charitable fundraising services

Basis: 1(a)

First Use Date: 1994-07-00

First Use in Commerce Date: 1994-07-00

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2006-08-31 - First renewal 10 year

2006-08-31 - Section 8 (10-year) accepted/ Section 9 granted

2006-08-11 - Assigned To Paralegal

2006-07-13 - Case File In TICRS

2006-05-17 - Combined Section 8 (10-year)/Section 9 filed

2006-05-17 - PAPER RECEIVED

2002-02-26 - Section 8 (6-year) accepted & Section 15 acknowledged

2001-12-11 - Section 8 (6-year) and Section 15 Filed

1996-07-30 - Registered - Principal Register

1996-06-04 - Allowed for Registration - Principal Register (SOU accepted)

1996-04-23 - Statement Of Use Processing Complete

1996-01-30 - Use Amendment Filed

1995-08-15 - NOA Mailed - SOU Required From Applicant

1995-05-23 - Published for opposition

1995-04-21 - Notice of publication

1994-12-01 - Approved For Pub - Principal Register

1994-11-29 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Susan Upton Douglass

Correspondent

SUSAN UPTON DOUGLASS

WEISS DAWID FROSS ZELNICK & LEHRMAN, PC

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NEW YORK, NY 10017-6754
